



UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of
Peter Emig et al
Serial No.: 09/910,141 : PETITION DECISION
Filed: July 10, 2001
Attorney Docket No.: 0691-070

This is a decision on the petition under 37 CFR 1.144, filed October 1, 2002, by facsimile transmission requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111. The examiner assigned to the application mailed a first Office action to applicants on August 6, 2002, setting forth a restriction requirement as follows:

Group I, claims 1-6 and 9-14 (all in part), drawn to compounds of formula I where X is carbon (an azine) and the ring has 7-10 members;
Group II, claims 1-6 and 9-14 (all in part), drawn to compounds of formula I where X is nitrogen (a diazine) and the ring has 7-10 members;
Group III, claims 1-6, 9-14 (all in part) and claims 7-8, drawn to compounds of formula I where X is nitrogen (a diazine) and the ring has six members;
Group IV, claims 1-6 and 9-14 (all in part), drawn to compounds (azines) not belonging to the above groups.

The examiner reasoned that each of the Groups was directed to a different type of compound based on the ring size and variable X identification.

Applicants replied on September 9, 2002, electing Group III with traverse arguing that the restriction requirement was improper because the nucleus was always the same and only the substituents on the nucleus varied. It was also argued that restriction could not be based on the size of the ring or on differing classification..

The examiner replied to the traversal in the next Office action, mailed September 27, 2002. The restriction requirement was made Final. The examiner also rejected claims 1-6 under 35 U.S.C. 102(b) over Sugihara et al; claim 12 under 35 U.S.C. 112, first paragraph as lacking written description in the specification; and claims 1-14 under 35 U.S.C. 112, second paragraph, as indefinite.

Applicants have not yet replied to the Office action, however this petition with respect to the restriction requirement was filed on October 1, 2002.

DISCUSSION

Applicants argue that the examiner ignored the traversal argument presented - "that the claims were directed to compounds having a single common nucleus and only substituent sidechains differed" - in the response to the restriction requirement.

A review of the restriction requirement has been made. The requirement has been made on the differences in Formula I. Formula I, in addition to including sidechains R, R₁-R₄, P, Q and Z, includes variable X within the single ring substituent of the basic quinoline ring. This substituent ring also contains two optional CH₂ groups having variable numerical values from 0 to 3 thus giving the ring a variable size. Classification of organic chemical compounds is complicated but provides a basis upon which orderly examination of applications may be made. Classification is based on ring size, ring member heteroatoms, both type and frequency, and multiple (fused) ring existence. An established hierarchy taking into account these and other factors has been established. It has further been established that differences in the number and type of ring members and/or ring size is sufficient basis for establishing restriction of compounds. Thus applicants' argument that the nucleus for all compounds encompassed by Formula I is incorrect as evidenced by the existence of variable X within the ring structure as well as the variable number of CH₂ ring members.

Contrary to applicants argument that the examiner did not address applicants' arguments in answering the traversal, page 2 of the last Office action responds clearly to applicants' traversal. The explanation given may not be the same as that above, however it clearly sets out the basis for restriction and for denial of applicants' traversal. Applicants' argument relating to a common or invariant nucleus appears to be based on consideration of the quinoline fused ring system as the basis for classification. However, the unfused hetero ring system may equally be looked to as the basis for classification depending on the number and type of heteroatoms.

DECISION

Applicants' petition under 37 CFR 1.144 is **DENIED** for the reasons set forth above.

Applicants remain under obligation to reply to the last Office action, mailed September 27, 2002, within the time period set, or as may be extended under 37CFR 1.136.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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